

Application Number: 10/521,858
Attorney Docket: NL 020681
Reply Brief

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant: Franciscus L. A. J. Kamperman

Examiner: Darren Schwartz

Serial No: 10/521,858

Group Art Unit: 2435

Filed: January 21, 2005

Docket: NL 020681

Confirmation No.: 1225

For: Secured Authenticated Distance Measurement

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
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REPLY BRIEF

In addition to the arguments presented in the Appeal Brief filed on July 22, 2009, and in response to the Examiner's Answer dated November 10, 2009, Appellant submits the following reply.

REMARKS

This Reply Brief is in response to the Examiner's Answer dated November 10, 2009. Reconsideration of this application is respectfully requested in view of the following remarks and all of the arguments in the appeal brief of July 22, 2009 and prior responses.

STATUS OF CLAIMS

- a) Claims 1, 3, 5 – 11 and 13 are pending. Claims 1, 8 and 11 are independent.
- b) Claims 2, 4 and 12 are cancelled without prejudice.
- c) Claims 1, 3, 5 – 11 and 13 stand rejected and are under appeal.

STATUS OF AMENDMENT

In the Appeal Brief, Appellant inadvertently made a typographical error, which incorrectly stated a response to the non-final office action dated October 1, 2008 was filed on December 31, 2009. As pointed out by the Examiner, this date is incorrect and should be December 31, 2008.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether claims 1, 5 – 11 and 13 are properly rejected under 35 U.S.C. §103(a) over Lundkvist (WO 02/035036 A1), in view of Blumenau et al., (U.S. Pat 6,493,825 B1), hereinafter Blumenau.

B. Whether claim 3 is properly rejected under 35 U.S.C. §103(a) over Lundkvist in view of Blumenau, in further view of Rofheart et al. (WO 01/93434 A2), hereinafter referred to as Rofheart.

ARGUMENT IN RESPONSE TO THE EXAMINER'S ANSWER

The Examiner responds to Appellant's remarks starting on page 9 of the Examiner's answer. Appellant respectfully disagrees to the Examiner's comments for at least the following reasons.

According to MPEP 2143.01, Section VI: *"If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious."*

Therefore, if combining Lundkvist and Blumenau would change the principle of operation of Lundkvist and Blumenau, a prima facie case of obviousness is not established.

On page 14 of the Examiner's answer, the Examiner asserted that Appellant failed to address the rejection as made by the Examiner. Appellant respectfully submits that Appellant fully understands the Examiner's position of applying Blumenau to Lundkvist according to the second exhibit on page 13 of the Examiner's answer and in previous Office Actions. However, as already discussed in Appellant's Appeal Brief, pages 8 – 9, and further elaborated below, Appellant submits that the Examiner's proposed combination of Blumenau and Lundkvist would change the principle operation of Blumenau and Lundkvist.

Blumenau, column 37, lines 46 – 47 and Fig. 33, element 381, clearly shows that it is the HOST CONTROLLER that sends a request in the first step of the process. Appellant submits that the first message sent by the HOST CONTROLLER in the first step of the process is omitted when the Examiner identified the STORAGE SUBSYSTEM PORT ADAPTER in Blumenau as the first communication device, because Fig. 33 clearly shows that the STORAGE

SUBSYSTEM PORT ADAPTER in Blumenau is the one that sends the second signal, not the first signal.

Therefore, Appellant contends that the issue is whether omitting the first message sent by the HOST CONTROLLER in the first step of the process in order to arrive at the position taken by the Examiner as depicted by the second exhibit on page 13 of the Examiner's answer would change the principle operation of Blumenau and Lundkvist.

Appellant submits that the roles of the first and second communication devices are very different and are not interchangeable, because the first communication device is the device that initiates the first signal transmission and the second communication device is the device that responds to the first signal transmission. Appellant submits that the operation of a device that initiates a communication is fundamentally different from the operation of a device that responds to a message, because the device that initiates a communication takes an active role whereas the device that responds to a message takes a passive role. Therefore, omitting the first message sent by the HOST CONTROLLER in the first step of the process and treating the STORAGE SUBSYSTEM PORT ADAPTER as the first communication device would necessarily require a substantial reconstruction and redesign of the elements as well as a change in the basic principle of operation in Blumenau and Lundkvist.

On page 16 of the Examiner's answer, the Examiner asserted that the "first signal" as claimed does not need to be an "initial" or "starting" signal. Appellant respectfully disagrees. Appellant submits that plain English meanings of "first" clearly include "initial" and "starting". Furthermore, the claim language in claim 1 includes "a first communication device to performing authenticated distance measurement," which implies that the first communication device is the

one that initiates the process and takes an active leading role. Hence, the “first” signal is clearly the “initial” or “starting” signal. Furthermore, the claim language also includes the elements: “first signal,” “second signal” and “third signal.” Therefore the signals are clearly sequential in time, with the “first” signal being the “initial” or “starting” signal. Thus, a skilled person in the art would naturally and reasonably identify the message 381 sent by the HOST CONTROLLER in the first step of the process of Blumenau’s Fig. 33 as the first signal, but would not unreasonably consider elements 383 and 384 as the claimed first signal.

On pages 16, 17 and 20, the Examiner asserted that Appellant failed to address the rejection as made by the Examiner. Appellant submits that as discussed above, combining Blumenau and Lundkvist would require a substantial reconstruction and redesign of the elements as well as a change in the basic principle of operation. Appellant’s Appeal Brief, pages 11 – 12, addresses Examiner’s rejection by discussing the reconstruction and redesign that were required if Blumenau and Lundkvist were forced to combined and the inconsistency resulted if the position of the Examiner was taken, and that therefore, it is not obvious to combine Blumenau and Lundkvist to arrive at the claimed invention.

On page 19 of the Examiner’s answer, the Examiner stated that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references, and that rather, the test is what the combined teachings of the references would have suggested to those of ordinarily skilled in the art. However, Appellant submits that according to MPEP 2143.01, Section VI: “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima

facie obvious.” As discussed above, combining Blumenau and Lundkvist would require a change in their principle operation and hence they would not work as initially intended, therefore, the combined teaching would not suggest a skilled person to arrive at the claimed invention.

CONCLUSION

As discussed above, the combination of references is woefully deficient in teaching each and every feature of Appellant’s claims and Appellant respectfully submits that the rejection of claims 1, 3, 5 – 11 and 13 is in error, legally and factually, and must be reversed.

Respectfully submitted,

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